

REMARKS

Initially, the Examiner has objected to the Abstract. Applicants have amended the Abstract to include the formula of claim 1 as required by the Examiner.

Claims 1 and 7 have been amended. Claim 6 has been cancelled and replaced by new claim 27. Claims 1-5 and 7-27 are in the application upon entry of this amendment. Entry of this amendment, and reexamination and reconsideration of the application are respectfully requested.

Claim Objections

Claims 9 and 11 are objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. The Examiner states that claims 9 and 11 refer to the nomenclature of claim 1, not claim 8 or 10, respectively. Applicants believe that claims 9 and 11 are proper. However, in order to further clarify the claims, Applicant's have cancelled claim 6 and added new claim 27.

Claim Rejections

Claims 1, 6, 7, 9, 13-15, 17, 18, 20-21 and 24-26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,660,448 to Tachibana, et al. In Tachibana there is taught a polymer having a mixture of norbornene-type repeating units and a repeating unit other than of a norbornene-type. (see, for example, column 27, line 33 – column 28 line 33). Applicants have amended claim 1, to include the limitation that the polymer contains only norbornene-type repeating units. New claim 27 includes similar language.

The Examiner asserts that compounds having $G=C()C$, $j=1$ or 2 , $T=H$, $q=0$, $n=0$ and $X=CH_2$ are taught in Tachibana. Claim 21 has been amended to include the limitation that when G is $-C(O)-$, T is $-Si(R^{20})_3$. Amended claims 1 and 27 are directed to polymers containing only norbornene-type repeating units. The polymers as taught in Tachibana include the recurring monomer units set forth in columns 11 and 12 which meet the foregoing limitations, but further include a repeating unit other than of a norbornene-type. Thus, the polymers of Applicants' amended claims 1, 21 and 27 are not taught by Tachibana.

With reference to Polymer 8 as shown at columns 57 and 58 of Tachibana, the Examiner states that Polymer 8 meets the limitations of claim 7, formula II-a, where X' is CH₂, n'=0, R₅-R₇=H and R₈ is -(CH₂)_bC(O)OR₁₄ and b=0, R₁₄ is a substituted C₅ cycloalkyl group. Applicants direct the Examiner's attention to Polymer 8, as well as Polymer 9. While it appears that these polymers contain a 100% norbornene-type backbone, if one adds the values given for "x" and "d" for these Polymers 8 and 9, the sum is only 0.5. It must follow then that the structures do not constitute the entirety of the polymer backbone. This is further supported by referring to Polymers 1-7 and 10-11, where the sum of "x", "d" and "e" is 1, and Polymer 12, where the sum of "x" and "d" is 1. Thus, Polymers 8 and 9 cannot include only norbornene-type repeat units, and Applicant's amended independent claims are not anticipated by the teachings of Tachibana, et al.

Claims 16 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tachibana, et al. These rejections, however, are all based on dependent claims, of which the independent claim is not taught by the cited Shimada reference. Therefore, the arguments of the Examiner are moot as Tachibana, et al cannot teach the claimed features of the preceding independent claim, making these rejected claims allowable also.

Claims 1, 4-10, 12, 21, and 24-26 have been rejected under 35 USC §102(e) as being anticipated by copending Application Publication No. 2005/0019638A1 to Ravikiran, et al, which has a common assignee with the instant application. The Examiner asserts that Ravikiran discloses a compound meeting the limitations of 1-a in claim 1.

Applicants submit herewith a Declaration under 37 CFR §1.132 that the invention disclosed but not claimed in the Ravikiran reference was derived from the inventor of this application, and thus is not an invention "by another". Accordingly, the rejection should be withdrawn.

Applicants acknowledge the Examiner's allowance of claims 2, 3, 11, 22 and 23 as containing allowable subject matter. However, the Examiner is respectfully requested to reconsider his rejections of the claims, and, upon such reconsideration, to withdraw same

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and a timely issuance of a notice of allowance for claims 1-5 and 7-27.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By



Neil A. DuChez, Reg. No. 26,725

1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113